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10/777,046	02/13/2004	Matthew Lerner	003797.00739	3923

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EXAMINER

TSUI, WILSON W

ART UNIT PAPER NUMBER

2178

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/777,046	<b>Applicant(s)</b> LERNER ET AL.	
	<b>Examiner</b> Wilson Tsui	<b>Art Unit</b> 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20040213, 20051005</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is filed in response to the application filed on 2/13/2004, IDS filed on 10/05/2005, and IDS filed on 2/13/2004.
2. Claims 1-20 are pending. Claims 1, 8, 11, 13, 14, 17, 19, and 20 are independent claims.

### ***Specification***

3. The abstract of the disclosure is objected to because the abstract is too short (less than 50 words). See comments below or MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested:

'Organization of Annotated Clipping Views'.

Correction is required.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 5, 8, 11, 14, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Schilit et al (US Patent: US 6,279,014 B1, issued: Aug. 21, 2001, filed: Sep. 15, 1997).

With regards to claim 1, Schilit et al teaches a system comprising:

- a) *An input for receiving said content and said annotations* (paragraph 0016: Whereas, memory 16, and 18 store/input the content and annotations respectively).
- b) *A processor creating a renderable image having said clips, wherein at least one of said clips is a combination of two or more annotations*: The processor renders an image having clips as shown in Fig. 5 and described in column 6, lines 5-23. Each clip can contain more than one user drawn digital ink annotations that are combined together based on time and space as described in paragraph column 5, lines 10-32.
- c) *An output for outputting said renderable image* (Fig. 4 is an output of the renderable image, as described in column 6, lines 5-23).

With regards to claim 2, Schilit et al teaches a system according to claim 1, wherein *said at least one of said clips includes additional content*: whereas each clip comprises a context portion (Schilit et al, column 6, lines 45-50), and addition content

Art Unit: 2178

information, such as attributes concerning the type (column 7, lines 23-26), identified content (column 7, lines 27-30), or time/date data (column 7, lines 35-39).

With regards to claim 5, Schilit et al teaches a system according to claim 1, further *comprising a storage storing said annotation* (column 3, Fig. 1, reference number 18: whereas, annotations are stored on storage device 18) *and an image of said content* (column 3, Fig. 1, reference number 16: whereas, an image of said content is stored on storage device 16). Furthermore, "memories 16 and 18 can be either distinct portions of a single memory" (column 4, Fig. 1, lines 14-15).

With regards to claim 8, Schilit et al teaches a method of displaying clips comprising the steps of:

- a) *Receiving at least two sets of an annotation and related content*: whereas, as shown in Fig. 3, each set of user drawn digital ink annotations (such as the first set 36, and a second set 38) and related content (context data and attributes in Step S260, Fig. 6) are received and processed by a process function block S280 in Fig. 6.
- b) *Combining said at least two sets*: (column 6, lines 5-23: whereas, the sets are combined into a single ordered list prior to display/output).
- c) *Displaying a combination of said at least two sets* (column 6, lines 5-23, Fig. 4: whereas, the combination of set 36, and set 38 are displayed into a single output display as shown in Fig. 4).

With regards to claim 11, Schilit et al teaches a method of displaying clips comprising the steps of:

Art Unit: 2178

- a) *Receiving at least two sets of an annotation and related content*, as similarly described in claim 8, and is rejected under the same rationale.
- b) *Filtering said at least two sets*: whereas, each annotation set can be filtered into different list views such as by attribute, type of adjacent material, or content of adjacent material (column 6, lines 5-23).
- c) *Combining the output of said filtering step* (column 6, lines 5-23: whereas, each list view contains output of the sets based upon the method of filtering chosen).
- d) *Displaying a combination of said filtering step* (column 6, lines 5-23: whereas, "the system visually presents the annotations in context using different list views").

With regards to claim 14, Schilit et al teaches a computer-readable medium having a program stored thereon, said program for displaying clips and comprising the steps of:

- a) *Receiving at least two sets of an annotation and related content*: as similarly described in claim 8, and is rejected under the same rationale.
- b) *Combining said at least two sets*, as similarly described in claim 8, and is rejected under the same rationale.
- c) *Displaying a combination of said at least two sets*, as similarly described in claim 8, and is rejected under the same rationale.

With regards to claim 17, Schilit et al teaches a computer-readable medium having a program stored thereon, said program for displaying clips and comprising the steps of:

Art Unit: 2178

- a) *Receiving at least two sets of an annotation and related content*, as similarly described in claim 11, and is rejected under the same rationale.
- b) *Filtering said at least two sets*, as similarly described in claim 11, and is rejected under the same rationale.
- c) *Combining the output of said filtering step*, as similarly described in claim 11, and is rejected under the same rationale.
- d) *Displaying a combination of said filtering step*, as similarly described in claim 11, and is rejected under the same rationale.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schilit et al (US Patent: US 6,279,014 B1, issued: Aug. 21, 2001, filed: Sep. 15, 1997), in further view of Ma et al (US Patent: 6,909,805 B2, published: Jun. 21, 2005, filed: Jan. 31, 2001).

With regards to claim 3, which is dependent on claim 1, Schilit et al teaches the use of bounding boxes for each annotation (Fig. 5, reference number 34, column 5, lines 8-9: *whereas, a clip comprising a bounding box, is used to select a context portion based on an annotation*). However, Schilit et al does not teach a clip *is a combination of two or more bounding boxes, said bounding boxes surrounding said annotations*.

Ma et al teaches a clip *is a combination of two or more bounding boxes, said bounding boxes surrounding said annotations*: whereas, a clip of annotation images extracted from an original scanned document is extracted in Fig 8. Furthermore, clip is a combination of bounding boxes surrounding annotations as shown in Fig. 7.

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Schilit et al's invention such that each segmented clip, includes a combination of two or more bounding boxes surrounding said annotations as taught by Ma et al. The combination of Schilit et al and Ma et al to have allowed Schilit et al's clips that each contain a bounding box, to further include the ability to contain a combination of two or more bounding boxes, for optimal manipulation of annotated data by reducing the number of boxes or image segments handled.

With regards to claim 4, which is dependent on claim 1, Schilit et al and Ma et al teaches the *clips are a combination of two or more bounding boxes, where said bounding boxes surround said annotations*, as explained in claim 3 above. Furthermore, each bounding box defines a *region/area* of the document of interest, as shown in Fig. 7 of Ma et al. Since each bounding box defines a region of interest, then claim 4, for a system performing the same method as the method in claim 3, is rejected under the same rationale.

7. Claims 6, 7, 10, 12, 13, 16, 18, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schilit et al (US Patent: US 6,279,014 B1, issued: Aug. 21, 2001, filed: Sep. 15, 1997), in further view of Amitay et al (US Application: US 2004/0216032 A1, published: Oct. 28, 2004, filed: Apr. 28, 2003).



With regards to claim 6, which is dependent on claim 1, for a system performing a method similar to claim 13, is rejected under the same rationale.

With regards to claim 7, which is dependent on claim 1, Schilit et al teaches a system for *storing annotations in* electronic documents (column 4, lines 39-40) and content (Fig. 1, reference number 16, column 3, lines 55-57) and *content* (Fig. 1, reference number 18, column 3, lines 62-63). However, Schilit et al does not teach *storing active content*.

Amitay et al teaches a *storage storing said annotation and active content*: whereas, annotations are stored along with an "image of at least a portion of the computer screen viewed by the user" (paragraph 0016). Furthermore, the content includes active content such as video (paragraph 0039: whereas, annotated electronic documents, include video or electronic whiteboards).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Schilit et al's system for storing annotations and content, to also include the storing of active content through the use of snap shot images as taught by Amitay et al. The combination of Schilit et al and Amity et al would have allowed Schilit et al's system to have organized and stored annotations for not only static content, but active content as well such that the context of the active content is preserved upon retrieval.

With regards to claim 10, which depends on claim 8, Schilit et al teaches a method for *combining said at least two sets* such that the combinations are represented

Art Unit: 2178

in list form, in claim 8, and is rejected under the same rationale. However, Schilit et al does not expressly teach *storing the combination* of said at least two sets are stored.

Amitay et al teaches combining annotations in a sorted list, for which the list is sorted in memory (paragraph 0063: whereas, a combination/set of annotations are sorted/manipulated in memory and thus, stored).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified the Schilit et al's annotation combinations to be stored in memory as taught by Amitay et al. The combination of Amitay et al and Schilit et al would have allowed Amitay et al's system to have stored a combination for later retrieval, thus reducing processing time.

With regards to claim 12, which depends on claim 11, for a method performing a method similar to claim 10, is rejected under the same rationale.

With regards to claim 13, Schilit et al teaches a method of storing and accessing clips comprising the steps of:

a) *Receiving data regarding a first annotation and data regarding a second annotation:* as similarly described in claim 8, and is rejected under the same rationale.

b) *Storing at least one of context information with said first and second annotation data or a link to context information with said first and second annotation data in a storage:* whereas, for each annotation, context information is stored as described in column 9, lines 1-8. As shown in the input, there are at least two sets of user drawn annotations (36, and 38), and using the procedure in Fig. 6, both first and second annotation data are stored.

However, Schilit et al does not teach *storing associations regarding one or more applications from which said first annotation and second annotation originate and wherein selection of one of said annotations accesses said one or more applications to display said annotations.*

Amitay et al teaches a method for:

- a) *Storing associations regarding one or more applications from which said first annotation and second annotation originate* (paragraph 0060: whereas, each annotation is stored such that there are additional fields of context data, including the application type of origin).
- b) *Wherein selection of one of said annotations accesses said one or more applications to display said annotations* (paragraph 0071: whereas, a workstation selects one or more annotations for display by following a link to the document using said one or more applications).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Schilit et al's context information for annotations, to further include the application type to indicate where the annotations have originated, and used the application type data to open the appropriate application when a selection for one or more annotations are made, as taught by Amitay et al. The combination of Schilit et al and Amitay et al would have allowed Schilit et al's system to have been able to "organize their annotations coherently and to review the annotations easily, even when the annotations extend over multiple, different electronic documents, multiple different screens" (Amitay et al, paragraph 0006).

Art Unit: 2178

With regards to claim 16, which depends on claim 14, for a computer readable medium having a program stored thereon, for performing a method similar to the method of claim 10, is rejected under the same rationale.

With regards to claim 18, which depends on claim 17, for a computer readable medium having a program stored thereon, for performing a method similar to the method of claim 10, is rejected under the same rationale.

With regards to claim 19, for a computer readable medium having a program stored thereon, for performing a method similar to the method in claim 13, is rejected under the same rationale.

With regards to claim 20, Schilit et al teaches a computer-readable medium having stored thereon:

a) Storing information relating to context information (column 9, lines 5-9), for which the context information includes at least one attribute of context information, and additional attributes of context information as described in column 7, lines 12-44.

However, Schilit et al does not teach a data structure stored thereon, said data structure comprising a *first field storing information relating to context information, a second field storing information relating to an annotation that adds information to said context information, and a third field storing a link to a document related to said context information, such that activation of said link opens said document.*

Amitay et al teaches a computer readable medium having a data structure stored thereon, said data structure comprising:

Art Unit: 2178

- a) *A first field storing information relating to context information* (paragraph 0042: whereas, a first field stores time related context information for a particular annotation).
- b) *A second field storing information relating to an annotation that adds information to said context information* (paragraph 0048: whereas, a second field stores the identity of the user creating the annotation)
- c) *A third field storing a link to a document related to said context information, such that activation of said link opens said document:* whereas, a third field stores the file name and application type of the document (paragraph 0043). Furthermore, the link opens the document (paragraph 0071: whereas, a workstation selects one or more annotations for display by following a link to the document using said one or more applications).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Schilit et al's storage of context information, to also store information in data structure comprising a set of fields, such that the fields contain additional context information, including a link used to open the document relating to the context information as taught by Amitay et al. The combination of Schilit et al and Amitay et al would have allowed Schilit et al's system to have been able to "store context information .... in a structured, hierarchical format" (Amitay et al, paragraph 0050).

8. Claims 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schilit et al (US Patent: US 6,279,014 B1, issued: Aug. 21, 2001, filed: Sep. 15, 1997),

Art Unit: 2178

in further view of Hugh et al (US Application: US 2002/0089551 A1, published: Jul. 11, 2002, filed: Jul. 13, 2001).

With regards to claim 9, which depends on claim 8, Schilit et al teaches *filtering at least two sets*, as explained in claim 11 above, and is rejected under the same rationale.

Furthermore, Schilit et al teaches *a combination of two sets*, as described in the rejection for claim 8 above, and is rejected under the same rationale. However Schilit et al does not teach *filtering said combination* of said at least two sets.

Hugh et al teaches a method for *filtering said combination* of annotation data: whereas, filtering can be performed on a combination/set of annotation data: whereas, filtering is performed using a result set of annotation/thought combinations (paragraph 0361). For clarification, the "thoughts" being filtered or organized comprise annotation data as described in paragraph 0563.

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Schilit et al's methods for filter and combining annotations, to also include the ability to perform the method of combining prior to filtering as taught by Hugh et al. The combination of Schilit et al and Hugh et al would have allowed Schilit et al's system to have provided a "filtered (result set which) can be tailored to suit the user's display preferences" (paragraph 0016).

With regards to claim 15, which is dependent on claim 14, for a computer-readable medium having a program stored thereon, for which the said program performs a method similar to the method of claim 9, is rejected under the same rationale.

### ***Conclusion***

Art Unit: 2178

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Bays et al (US Patent: US 6,519,603 B1, published: Feb. 11, 2003, filed: Oct. 28, 1999): This reference teaches methods for organizing and retrieving annotations.
- Golovchinsky et al (US Application: US 2004/0078757 A1, published: Apr. 22, 2004, filed: Aug. 31, 2001): This reference teaches methods for processing annotation data, digital ink, bounding boxes, and annotation linking.
- Price et al (US Patent: 6,766,494 B1, published: Jul. 20, 2004, filed: Jun. 15, 1988): This reference teaches linking annotations and storage/use of contextual data.
- Lerner et al (US Patent: US 6,859,909 B1, published: Feb. 22, 2005, filed: Mar. 7, 2000): This patent teaches annotating web documents, selecting portions of a web document, and organizing web annotated documents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wilson Tsui whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

W. T. 3/22/2006

Wilson Tsui  
Patent Examiner  
Art Unit: 2178  
March 22, 2006

  
STEPHEN HONG  
SUPERVISORY PATENT EXAMINER